



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,791	10/22/2003	Alan R. Hirsch	INS-31875(1)	5622
22202 7590 02/24/2012 WHYTE HIRSCHBOECK DUDEK S C INTELLECTUAL PROPERTY DEPARTMENT 555 EAST WELLS STREET, SUITE 1900 MILWAUKEE, WI 53202				
EXAMINER FLOOD, MICHELE C				
ART UNIT 1655		PAPER NUMBER		
NOTIFICATION DATE 02/24/2012		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ptomailbox@whdlaw.com
jpolmatier@whdlaw.com

Office Action Summary**Application No.**

10/690,791

Applicant(s)

HIRSCH, ALAN R.

Examiner

MICHELE FLOOD

Art Unit

1655

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2012.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 5) ☒ Claim(s) 50-64 is/are pending in the application.
- 5a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 6) ☐ Claim(s) ____ is/are allowed.
- 7) ☐ Claim(s) ____ is/are rejected.
- 8) ☐ Claim(s) ____ is/are objected to.
- 9) ☒ Claim(s) 50-64 are subject to restriction and/or election requirement.

Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/c3)
Paper No(s)/Mail Date ____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 29, 2011 has been entered.

Acknowledgment is made of the cancellation of Claims 1-4, 7-9, 26, 27 and 42-49; and the addition of new Claims 50-64.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 50-62, drawn to a method of modifying a male person's estimation of body weight of a female person having a body mass index (BMI) of about 25 or greater, the method comprising administering an effective amount of an odorant composition that is hedonically positive to the male person for inhalation; and following said inhalation, having the male person observe said female person and estimate the body weight of said female person; wherein said estimate of said body weight is lowered by a statistically significant amount compared to the male person's estimate of said body weight of said female person in the absence of inhalation of said

odorant composition; the odorant composition comprising a suprathreshold but non-irritant concentration of a mixture of a floral odorant and a spice odorant, the floral odorant selected from the group consisting of jasmine, lilac, lily of the valley, magnolia, rose, lavender, geranium, hyacinth, orange blossom, apple blossom, carnation and mixtures thereof, and the spice odorant selected from the group consisting of cinnamon, ginger, cloves, nutmeg, oriental spice and mixtures thereof, classified in class 424, subclass 725.

- II. Claim 63, drawn to a method of modifying a male person's estimation of body weight of a female person having a body mass index (BMI) of about 25 or greater, the method comprising administering an effective amount of an odorant composition that is hedonically positive to the male person for inhalation; and following said inhalation, having the male person observe said female person and estimate the body weight of said female person; wherein said estimate of said body weight is lowered by a statistically significant amount compared to the male person's estimate of said body weight of said female person in the absence of inhalation of said odorant composition; the odorant composition comprising an odorant mixture consisting essentially of a floral odorant and a spice odorant, each of said odorants being present in a suprathreshold but non-irritant concentration; the floral odorant selected from the group consisting of jasmine, lilac, lily of the valley, magnolia, rose, lavender, geranium, hyacinth, orange blossom,

apple blossom, carnation and mixtures thereof, and the spice odorant selected from the group consisting of cinnamon, ginger, cloves, nutmeg, oriental spice and mixtures thereof, classified in class 424, subclass 725.

- III. Claim 64, drawn to a method of modifying a male person's estimation of body weight of a female person having a body mass index (BMI) of about 25 or greater, the method comprising administering an effective amount of an odorant composition that is hedonically positive to the male person for inhalation to lower the male person's estimate of body weight of said female person upon being observed by the male person following said inhalation by a statistically significant amount compared to the male person's estimate of said body weight of said female person in the absence of inhalation of said odorant composition; the odorant composition comprising an odorant mixture consisting essentially of a floral odorant and a spice odorant, each of said odorants being present in a suprathreshold but non-irritant concentration; the floral odorant selected from the group consisting of jasmine, lilac, lily of the valley, magnolia, rose, lavender, geranium, hyacinth, orange blossom, apple blossom, carnation and mixtures thereof, and the spice odorant selected from the group consisting of cinnamon, ginger, cloves, nutmeg, oriental spice and mixtures thereof, classified in class 424, subclass 725.

The inventions are distinct, each from the other because of the following reasons:

Inventions I-III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the three different groups are directed to three different methods encompassing different experimental parameters and different process steps. These methods are independent since they are disclosed as capable of use together, they have different modes of operation, they have different functions, and/or they have different effects. One would not have to practice the various methods at the same time to practice just one method.

Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and/or examination burden if restriction were not required because at least the following reason(s) apply:

(a) the inventions have acquired a separate status in the art in view of their different classification;

(b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;

(c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries), in particular therapeutic considerations;

(d) the prior art applicable to one invention would not likely be applicable to another invention;

(e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHELE FLOOD whose telephone number is (571)272-0964. The examiner can normally be reached on 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on 571-272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michele Flood
Primary Examiner
Art Unit 1655

MCF
February 18, 2012
/Michele Flood/
Primary Examiner, Art Unit 1655